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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,125

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Norihiro Tokita

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02/17/2004

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EXAMINER

PIERCE, JEREMY R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,125

Applicant(s)

TOKITA ET AL.

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on December 3, 2003 has been entered. Claims 1 and 4 have been amended. Claims 2 and 3 have been cancelled. New claim 12 has been added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Abuto et al. (U.S. Patent No. 5,964,743).

Abuto et al. disclose an absorbent material for personal care products having a topsheet, backsheet, and an absorbent core (column 5, lines 20-26). The topsheet may be made from an apertured or perforated film (column 5, lines 15-19). Such a topsheet may be completely hydrophobic (column 7, lines 1-2), and Abuto et al. disclose that hydrophobic material has a contact angle of greater than 90 degrees (column 2, lines 5-6). With regard to the limitation of the film being extrusion laminated and processed to have the through-holes, Abuto et al. teach providing either a previously produced film or newly formed film (column 15, lines 3-8). Additionally, Abuto et al. teach thermal

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bonding may be used to bond the film to the nonwoven (column 15, line 2). Thus, the final product of Abuto et al. would have the same structure as that created by Applicant's claimed extrusion laminating, since both methods create bonding by heating the film to a molten level so that it adheres to the fibrous layer. With regard to claim 5, the absorbent core may comprise natural or synthetic fibers (column 15, lines 14-40). With regard to claim 6, the absorbent material may be treated with anti-static treatment (column 14, lines 43-50). With regard to claim 7, the electrostatic chargeability of the topsheet and the absorbent layer would be lower than the topsheet alone because the antistatic agent is incorporated into the absorbent layer. With regard to claim 8, Abuto et al. disclose a surge layer may be used between the absorbent layer and the topsheet (column 8, lines 45-47). The electrostatic chargeability of the surge layer would be lower than the topsheet, since the absorbent core contains antistatic material.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Terada (EP 320,314).

Terada discloses an absorptive sheet for food packaging comprising a water absorptive nonwoven sheet and a protective sheet (Abstract). Terada discloses the

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protective sheet may be a perforated film (column 3, lines 24-27). Terada disclose using hydrophobic polymers for the film, such as polyethylene and polypropylene (column 3, lines 15-16), and do not disclose adding surfactant. However, Terada does not teach the film to have a contact angle of at least 35 degrees. Although Terada does not explicitly teach the contact angle limitation, it is reasonable to presume that said limitation is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. apertured film material made from hydrophobic polymers) and in the similar production steps (i.e. laminating the film to a fibrous absorbent material) used to produce the food-packaging sheet. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed contact angle would obviously have been provided by the process disclosed by Terada, since the reference teaches using apertures to provide a means to allow the liquid pass through the film and does not rely on any hydrophilic property. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to the limitation of the film being extrusion laminated and processed to have the through-holes, Terada teaches using lamination bonding via hot rolls (column 2, lines 60-62). Thus, the final product of Terada would have the same structure as that created by Applicant's claimed extrusion laminating, since both methods create bonding by heating the film to a molten level so that it adheres to the fibrous layer. With regard to claim 4, the apertures may extend through to the nonwoven (Figure 1). With regard to claim 5, Terada discloses using synthetic fibers (column 2, lines 21-57).

6. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abuto et al.

Although Abuto et al. do not explicitly teach the charge level of the liquid-absorbing layer is at most $1/50^{\text{th}}$ of that of the liquid pervious layer, it is reasonable to presume that said limitation is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. apertured film material made from hydrophobic polymers and liquid absorbing layer of natural or synthetic fibers) and in the similar production steps (i.e. providing anti-static agent to the absorbing layer and laminating the film to it) used to produce the absorbent sheet. The burden is upon the Applicant to prove otherwise. In the alternative, the claimed charge level of the two layers would be obvious to provide. The amount of anti-static agent applied to the fibrous absorbent layer would be a result effective variable that would affect the layer's resistance to charge (i.e. an increase in anti-static agent provides for less potential of charge within the layer). It would have been obvious to a person having ordinary skill in the art at the time of the invention to increase the amount of anti-static agent in the fibrous layer in order to increase charge resistance since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim Rejections - 35 USC § 103

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abuto et al.

Abuto et al. disclose that anti-static agents may be incorporated into the absorbent materials (column 14, lines 43-50). However, it is not clear whether the optional surge layer is considered as part of the "absorbent materials." Certainly, the surge layer works in conjunction with the absorbent layer, and to a large degree, performs a similar function in that it also holds liquid. Even if the surge layer were not classified as an absorbent material according to Abuto et al., it would still be obvious to a person having ordinary skill in the art to incorporate anti-static agent into it, in order to provide increased anti-static properties to the fibrous materials of the absorbent article, since Abuto et al. already teaches applying such treatment to the absorbent fibers of the invention.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abuto et al. in view of Arteman et al. (U.S. Patent No. 5,986,167).

Abuto et al. do not teach that the absorbent layer has through holes in communication with the topsheet. Arteman et al. teach that improved fluid intake can be achieved with absorbent material having apertures that extend down into the core (Abstract). It would have been obvious to one having ordinary skill in the art to have the apertures of Abuto et al. extend into the absorbent core material in order to increase fluid intake of the personal care garment, as taught by Arteman et al.

Response to Arguments

9. Applicant's arguments filed on December 3, 2003 have been fully considered but they are not persuasive.

10. Applicant argues that neither Abuto et al, Arteman et al., nor Terada teach "the liquid-pervious layer is a resin film which is extrusion laminated onto the liquid-absorbing layer and processed to have the through-holes." This limitation is a processing step in a product claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In this case, Applicant's extrusion lamination method is a thermal bonding method that joins the film to the fabric. Abuto et al., Terada, and even Arteman et al. (column 9, lines 17-18) all disclose thermal bonding as well. The product created by the Abuto et al. and Terada references would be structurally similar to the claimed invention, even if the processing steps in creating the product vary.

11. Applicant argues that neither Abuto et al. nor Arteman et al. are related to absorbing drips that ooze from food. In response to applicant's arguments, the recitation of "sheet for absorbing drips oozing from a food" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA

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1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Additionally, using the sheet for absorbing drips oozing from food is the recitation of an intended use of a product. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571)

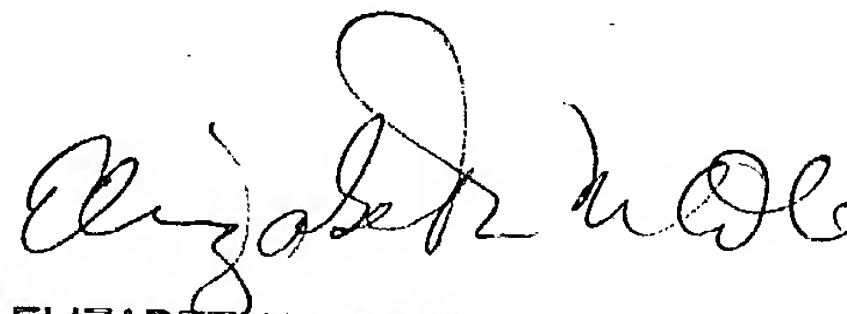
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272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ELIZABETH M. COLE
PRIMARY EXAMINER